

REMARKS

Claims 13, 14 and 16-29 were rejected under 35 U.S.C. § 112, first paragraph. Particularly, because the upper limit of oxygen content of 10.2% by mass is derived from a comparative example, the Examiner did not consider such to represent Applicants' invention. The Examiner was of the view that the claimed upper limit of 10.2% by mass is not supported by the specification as originally filed and introduces new matter into the specification.

Applicants traverse, and respectfully request the Examiner to reconsider for the following reasons.

It is respectfully submitted that the Examiner has not properly applied the criteria for determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph. An Applicant shows possession of the claimed invention (at the time of the filing of the application) by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams and formulas that fully set forth the claimed invention. See MPEP §2163.02. Nowhere does the MPEP state or imply that comparative examples cannot be used to show possession of the claimed invention. If the Applicant draws certain claim limitations from the comparative examples, then the question is whether such claim encompasses the prior art, not whether the limitation, fully supported in the specification as originally filed, "introduces new matter".

There is no question that at the time the application was filed, Applicants had possession of the claimed invention having an upper limit of the oxygen content of 10.2% by mass. This upper limit is clearly given in Comparative Example 4 of Table 2, which was present in Applicants' specification as originally filed.

Perhaps the Examiner meant to pose the rejection under 35 U.S.C. § 112, second paragraph, which requires that the claims particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. However, as clearly set out in MPEP §2172(III), the Applicant is permitted to change what they regard as their invention during pendency of the application. Namely, the fact that the upper limit of 10.2% by mass is directed to originally disclosed subject matter which the Applicants may not have previously regarded as being part of the invention is irrelevant, and does not prevent Applicants from now claiming that subject matter.

For the above reasons, it is respectfully submitted that claims 13, 14 and 16-29 fully comply with 35 U.S.C. § 112, and withdrawal of the foregoing rejection is respectfully requested.

Claims 14 and 16-29 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent 6,671,164. The Examiner cited the claims of U.S. '164 as disclosing a sintered body formed from a niobium granulated powder having an oxygen content overlapping in scope with the present claims.

In response, the common Assignee submits herewith a Terminal Disclaimer, disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of prior U.S. Patent No. 6,671,164, to thereby obviate the foregoing obviousness-type double patenting rejection.

Withdrawal of all rejections and allowance of claims 13, 14 and 16-29 is earnestly solicited.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/727,548

Q78483

In the event that the Examiner believes that it may be helpful to advance the prosecution of this application, the Examiner is invited to contact the undersigned at the local Washington, D.C. telephone number indicated below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Abraham J. Rosner
Registration No. 33,276

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: December 2, 2005